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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,097	11/27/2001	Nick (Nicholas Sheppard) Bromer		9382

7590

09/16/2002

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EXAMINER

KLEBE, GERALD B

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 09/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/995,097

Applicant(s)

Bromer

Examiner  
Gerald Klebe

Art Unit  
3618



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONEO (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 21, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-17 is/are pending in the application.
- 4a) Of the above, claim(s) 4, 7, and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 5, 6, 8, 9, and 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Orefitperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Amendment(s)***

1. The amendment filed 5/29/2002 under 37 CFR 1.111 has been entered in part; the request to enter a substitute paragraph into the specification has not been entered as Applicant has not identified where the entry should be made. By this amendment claim 1 was canceled, claims 2-12 were amended, and new claims 13-16 were entered. Further, the Second Amendment filed 6/21/2002 under 37 CFR 1.111 has been entered. By this Second Amendment, new claim 17 was added. Upon entry of these amendments, claims 4, 7, and 10 being drawn to a non-elected species and having been withdrawn from further consideration, in the previous Office action, claims 2, 3, 5, 6, 8, 9, and 11-17 are pending.

### ***Acknowledgment--Election/Restriction without Traverse***

2. In the "Remarks" accompanying the amendment filed 5/29/2002, Applicant states that he did not traverse the election requirement on March 18, 2002 as indicated in the Office action mailed 4/01/2002, and that Applicant withdraws any such traversal if the PTO maintains assertion that there was traversal of the restriction requirement. Consequently, the Applicant's withdrawal of traversal the restriction requirement, if made, is hereby acknowledged.

### ***Oath/Declaration***

3. The Oath/Declaration filed 11/27/2001 is defective. It has not been dated and the post office address of the applicant is not provided; and does not identify the application being attested to. A new Oath/Declaration in compliance with 37 CFR 1.67(a) identifying this

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application by application number and filing date is required. See MPEP Sections 602.01 and 602.02.

### *Specification Objections*

4. The specification, including the drawings, is objected to as it relates to connection and operation of elements of the skate and brake mechanism, particularly regarding the disclosure of Figure 1.

Figure 1 shows the pivot arm structure 100 being pivotally hinged on pin 130 (which is coaxial with the axle of the second wheel W2 of the skate) and extending forwardly and upwardly (arm 120) to the toe-cap lifter 110, and forwardly and downwardly from the hinge pin (as arm extension 140 which terminates in the brake shoe 150). The structure 100 appears to be a planar structure pivoted on the axis 130 and no further details of the structure are provided in the specification to modify this interpretation of the structure as being planar. A number of "enablement" problems appear to be present, therefore, in the disclosure: 1) as shown, the structure would appear to have the brake shoe 150 engage the side of the wheel W1 rather than its tread since the extension arm 140 appears to lie transversely the outside plane of both wheels (the second wheel W2 whose axle it is pivotally attached to, and the front wheel to be braked, W1); 2) the wheel truck structure (T) for known in-line skates would be expected to occupy the position shown occupied by the pivot arm lift structure 100, and so mechanical interference between the truck and the pivot arm would exist; and 3) the pivot arm lift structure 110 is shown to be outside the lateral edge of the skate plate (unnumbered in the Figures shown) to which the

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boot is affixed, such that it is not clear how the brake shoe could engage the surface of the wheel that in known in-line skates would be underneath on the centerline of the skate plate.

Appropriate clarification or correction is required.

***Claim Objections--Minor Informalities***

5. Claim 17, in line 2 appears to be missing the word --and-- between "shoe" and "is".

Appropriate clarification or correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 2-3, 5-6, 8-9, and 11-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. .

Independent claim 2 recites limitations of a skate braking mechanism wherein a lifter is connected to a brake whereby the brake is actuated (i.e., to brake the skate) by the user pressing the lifter upward with his toe; independent claim 8 recites limitations of a skate brake actuated by dorsiflexion wherein the brake comprises a lifter, a brake shoe coupled to the lifter to bear on a wheel of the skate brake wherein the brake shoe is pivoted to rotate about an axle of another

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wheel; and, independent claim 16 recites limitations of a skate braking mechanism comprising a brake and means for actuating the brake by pressing upward the toe of the user.

These recitations are not enabled by the disclosure, including the drawings, since it appears that there would be mechanical interference among the structures of the brake mechanism to prevent the pivotal motion of the braking structure or to enable the brake shoe to engage the braking wheel of the skate.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 17, in line 2, recites the limitation "another wheel", and in lines 2, 3 recites the limitation "the one wheel". There is insufficient antecedent basis for either of these limitations in the claim.

Appropriate correction or clarification is required.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 2, 3, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Intengan (US 6053511).

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Intengan discloses, for a user having a toe and standing on a skate, a skate braking mechanism comprising: a brake (55) and a lifter (combination of 42, 46, 47, 48, 49 54, 56) connected to the brake and pressable upward by the toe of the user to actuate the brake (refer to Fig 3A), whereby the brake is actuated according to a natural motion of the user to maintain balance (refer col 2, lines 31-37); and further (re: claim 3) wherein the lifter is pivoted (about the pivots 54 and 47-48) to be moved upward by the toe; and further (re: claim 12) comprising a return spring (53) counteracting an upward pressing motion of the toe.

12. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Carlsmith (US 5232231).

Carlsmith discloses (Fig 2) a skate braking mechanism for a user having a toe and standing on a skate, wherein the braking mechanism comprises a brake (the ground engaging device shown depending from the rear of the skate) and means for actuating the brake by pressing upward the toe of the user (as shown in Fig 2, the user presses upward the toes of the foot in the skate to be braked, thereby elevating the front of the skate upwardly and thereby bringing the brake into contact with the ground).

### ***Response to Argument***

13. Relative to the rejection of claims using the reference due to Intengan, Applicant argues that the reference states that the foot is made to "arch" with the toes pressed downward and that this is opposite to the claimed toe motion. The examiner points out that the language of the claim is interpreted broadly as the movement of the toes to press upward the brake lifter mechanism.

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Regarding Applicant's request for a showing that urethane and fiber-reinforced elastomers are materials old and well-known in the skate arts, the Applicant is referred to the reference to Carlsmith cited in the previous Office action for use of urethane and fiber reinforced polymers in the manufacture of in-line skates (refer to column 7, lines 46-49, and column 9, lines 22-26).

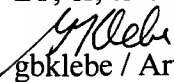
Regarding Applicant's further arguments, these have been fully considered but are moot in light of the new grounds of rejection.

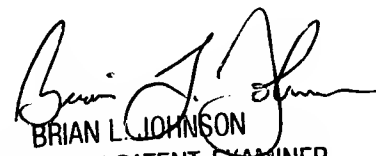
***Prior Art made of Record***

14. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure; the prior art of Oyen et al. teaches the use of fiber reinforced urethane polymer elastomer materials in the construction of in-line skates.

***Conclusion***

15. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe, at 703-305-0578; fax 703-308-2571; Mon.-Fri. 8:00 AM-4:30 PM ET; or, to Supervisory Patent Examiner Brian L. Johnson, Art Unit 3618, at 703-308-0885.

  
gbklebe / Art Unit 3618 / 10 September 2002

  
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9/10/02